

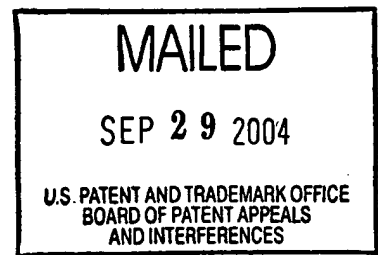
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DENNIS M. O'CONNOR and MARK P. CHUANG

Appeal No. 2003-1753
Application No. 09/150,577

ON BRIEF



Before HAIRSTON, FLEMING, and BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-5, 11, 13, 14, 16, 17, 20, 21, 23, and 24.

The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm.

BACKGROUND

The invention at issue on appeal records and plays back a video stream. A video cassette recorder ("VCR") records a video stream on a video cassette. After recording, the VCR is used to rewind the video cassette and play back what was recorded. (Spec. at 1.)

The appellants observe that once recording commences, however, the part of the video stream already recorded cannot be played back until the recording is finished. Consider a user who knows he will miss the first few minutes of a two-hour television show. He programs a VCR to record the whole show. When the user arrives home, he must wait for the entire show to be recorded before he can start watching it from the beginning. (*Id.*)

In contrast, the appellants' invention allows parts of a video stream to be alternately written to, and read from, a storage device. The next part to be written to the storage is temporarily stored in a buffer while another portion is being read from the storage. (*Id.* at 2.) Because the invention decouples recording and playback, the appellants explain, a user may begin watching a recorded show before it is completely recorded. (*Id.* at 5.)

A further understanding of the invention can be achieved by reading the following claim.

1. A method of allowing a video stream to be displayed and recorded comprising:

allowing a first portion of a video stream to be written to a storage medium while a second portion of a video stream is being read from a storage medium; and

providing a zoom function so that the second portion may be scaled for implementing the zoom function while said first portion of the video stream is being written.

Claims 1-5, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,134,499 ("Sata") and U.S. Patent No. 6,335,730 ("Gould").

Claims 11, 13, 14, 20, 21, 23, and 24 stand rejected under § 103(a) as obvious over Sata; Gould; and U.S. Patent No. 5,432,769 ("Honjo").

OPINION

"[T]o assure separate review by the Board of individual claims within each group of claims subject to a common ground of rejection, an appellant's brief to the Board must contain a clear statement for each rejection: (a) asserting that the patentability of claims within the group of claims subject to this rejection do not stand or fall together, and (b) identifying which individual claim or claims within the group are separately patentable and the reasons why the examiner's rejection should not be sustained." *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) (citing 37 C.F.R. §1.192(c)(7) (2001)). If the brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim." *Id.*, 63 USPQ2d at 1465.

Here, the appellants stipulate, "on appeal, claims 2-5, 16, and 17 may be grouped with claim 1; claims 13, 14, and 20 may be grouped with claim 11; and claims 23 and 24 may be grouped with claim 21." (Appeal Br. at 11.) We select claims 1, 11, and 21 from the groups as representative of the claims therein. With this representation in mind, our opinion addresses the claims in the following order:

- claims 1-5, 16, and 17
- claims 11, 13, 14, and 20
- claims 21, 23, and 24.

A. CLAIMS 1-5, 16, AND 17

Rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the point of contention therebetween. The examiner finds that Sata "disclose[s] the claimed feature of writing a portion of video stream to a recording medium while another portion of a video stream is being read from the recording medium." (Examiner's Answer at 6-7.) He further finds that Gould "disclose[s] the feature of providing a zoom function to reproduced video data from a recording medium. . . ." (*Id.* at 7.) The examiner concludes, "when the cited reference of Sata is modified in view of Gould's apparatus for . . . incorporating in . . . Sata's reproducing means the capability of applying a zoom function to the reproduced data . . . such a claimed invention . . . would be present in the proposed combination of Sata and Gould." (*Id.*) The appellants argue, "Gould does not teach doing the zoom function on

the second portion while the first portion of the video stream is being written." (Appeal Br. at 12.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the representative claim at issue to determine its scope. Second, we determine whether the construed claim would have been obvious.

1. Claim Construction

"Analysis begins with a key legal question — *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000).

Here, claim 1 recites in pertinent part the following limitations: "allowing a first portion of a video stream to be written to a storage medium while a second portion of a video stream is being read from a storage medium; and providing a zoom function so that the second portion may be scaled for implementing the zoom function while said first portion of the video stream is being written." Giving the representative claim its broadest, reasonable construction, the limitations require writing a first part of a video

stream to a storage medium while a second part of the video stream is being read therefrom in a zoomed format.

2. Obviousness Determination

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1383, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)). "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references." *In re Merck*, 800 F.2d, 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). "Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985) (quoting *Keller*, 642 F.2d at 425, 208 USPQ at 881).

Here, Sata discloses "a video recording apparatus . . . for recording/reproducing picture information of a television system." Col. 1, ll. 10-12. More specifically, the "apparatus . . . writes video information on a track formed on a recording medium in a writing direction which directs from a predetermined start position to a predetermined end position of track by use of a head. Thereafter, the video information is read from a desirable designated position of the track in the writing direction." Abs., ll. 1-8. The examiner's finding that the video recording apparatus writes a first part of a video stream to a storage medium while a second part of the video stream is being read therefrom is uncontested. Furthermore, the reference supports the finding by disclosing that the apparatus "can simultaneously play back and reproduce the previous part of the television program the moment the VTR 8 continuously records the current part of the television program." Col. 7, ll. 29-33.

Turning to the secondary reference, Gould's invention relates to "tools to improve user perspectives and enhance navigation or browsing of information sources. . . ." Col. 1, ll. 9-11. "FIG. 12 depicts application of the invention to video, for example, with Apple QuickTime video. QuickTime allows a user to play through a video presentation with a window just like playing a video tape on a VCR, except that QuickTime also allows editing of one or more of the frames making up the video." Col. 6, ll. 29-34. The examiner's finding that the invention allows the video to be played back in a zoomed

format is uncontested. Furthermore, the secondary reference supports the finding by disclosing that "not only is the user allowed to select and display the scope of salient segments, but as a further feature allows the user to **vary the degree of magnification** of the salient segments," col. 7, ll. 10-13 (emphasis added), and by describing its "zoom control function," col. 9, l. 60, as an "important aspect[] of the invention. . . ." *Id.* at l. 53.

Gould's "major benefit[]" is to allow users to quickly navigate through a large information space and to control the salience of the displayed information in the context of the full display while conserving display area, sometime called desktop real estate." Col. 2, ll. 44-48. "Moreover, maintaining a single window for the data and giving users the ability to visually navigate across the whole data via the scroll bar together with the ability to select the salient segments as well as the level of zoom, all in a single step, greatly enhances the ability of the user to cope intelligently and rapidly with large information structures containing large numbers of objects." *Id.* at ll. 48-54.

Because Sata's video recording apparatus writes a first part of a video stream to a storage medium while a second part of the video stream is being read therefrom, and Gould's invention allows video to be played back in a zoomed format to enhance the ability of the user to cope intelligently and rapidly with information, we conclude that the combined teachings of the references would have suggested writing a first part of a

video stream to a storage medium while a second part of the video stream is being read therefrom in a zoomed format. Therefore, we affirm the obviousness rejection of claim 1 and of claims 2-5, 16, and 17, which fall therewith.

B. CLAIMS 11, 13, 14, AND 20

The examiner finds, "in Sata's Figure 1, components 3-5, and claim 1 . . . it is disclosed a writing head which can move independently from a reading head, therefore, such a capability of alternating writing while reading video data to and from a storage device would be a present characteristic of Sata et al's apparatus because both heads (writing and reading) as disclosed are independently controlled." (Examiner's Answer at 7-8.) The appellants argue, "in the parent case, the Board determined that multiplexing reads and writes was not shown in Sata." (Appeal Br. at 12.)

1. Claim Construction

"[L]imitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Here, contrary to the appellants' argument, the limitations of claim 11 do not require multiplexing reads and writes. Instead, the representative claim recites in pertinent part the following

limitations: "allowing portions of the video stream to be alternately written to and read from a storage device. . . ."

2. Obviousness Determination

"In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). After a *prima facie* case of obviousness has been established, the burden of going forward shifts to the applicant. Rebuttal is . . . 'a showing of facts supporting the opposite conclusion'. . . ." *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (quoting *In re Heldt*, 433 F.2d 808, 811, 167 USPQ 676, 678 (CCPA 1970)).

Here, the examiner has met his burden by offering the aforementioned finding of why "alternating writing while reading video data to and from a storage device would be a present characteristic of Sata et al's apparatus. . . ." (Examiner's Answer at 8.) The appellants fail to address, let alone rebut, the examiner's finding. Therefore, we affirm the obviousness rejection of claim 11 and of claims 13, 14, and 20, which fall therewith.

C. CLAIMS 21, 23, AND 24

The examiner concludes, "the claimed feature of the buffer size being greater or equal to the time it takes to read or write from two buffers to and from the storage device would also be present in the proposed combination of Sata et al and Honjo." (Examiner's Answer at 8.) He explains that the "proposed combination already includes the capability of reading and writing data to and from the two buffers at a time (See the buffers that would have to be incorporated before the recording means and after the reproducing means; and the capability of writing and reading at the same time, since, the heads are independently controlled). Therefore the size of the buffers would necessarily be at least equal to the time it takes to read and write to and from the buffers and to and from the storage device." (*Id.*) The appellants argue, "[i]t is not believed that claim 22 has ever been specifically addressed in any office action to date." (Appeal Br. at 12.)

Again, the examiner has met his burden by offering the aforementioned explanation of why "the size of the buffers would necessarily be at least equal to the time it takes to read and write to and from the buffers and to and from the storage device." (Examiner's Answer at 8.) The appellants again fail to address, let alone rebut, the examiner's explanation. Therefore, we affirm the obviousness rejection of claim 21 and of claims 23 and 24, which fall therewith.

CONCLUSION

In summary, the rejections of claims 1-5, 11, 13, 14, 16, 17, 20, 21, 23, and 24 under § 103(a) are affirmed.

"Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences. . . ." 37 C.F.R. § 1.192(a). Accordingly, our affirmance is based only on the arguments made in the brief. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.") No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

KENNETH W. HAIRSTON
Administrative Patent Judge


MICHAEL R. FLEMING
Administrative Patent Judge

~~LANCE LEONARD BARRY~~
~~Administrative Patent Judge~~

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